



123

Docket 78685F-P  
Customer No. 01333AF  
300

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
John R. Fredlund, et al

Group Art Unit: 3722

SYSTEM FOR DISPLAYING,  
STORING AND RETRIEVING IMAGES

Examiner: Willmon Fridie, Jr.

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Serial No. 09/213,169

Paula West  
Paula West

Filed 30 November 2000

3-22-04  
DateCommissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Transmitted herewith is Applicants Reply Brief in the above-identified application:

- ☒ No additional fee is required.
- ☐ The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)	OTHER THAN A SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		* HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL	60	MINUS	60	0	X 18	\$0
INDEP	6	MINUS	6	0	X 86	\$0
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM					+ 290	\$0
TOTAL						\$0

\* The "Highest Number Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

- ☐ Please charge my Eastman Kodak Company Deposit Account No. 05-0225 in the amount of \$0.

A duplicate copy of this sheet is enclosed

- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Eastman Kodak Company Deposit Account No. 05-0225

A duplicate copy of this sheet is enclosed

- ☒ Any additional filing fees required under 37 CFR 1.16.

- ☒ Any patent application processing fees under 37 CFR 1.17.  
(For Extensions of Time and other Petitions to the Assistant Commissioner)

Frank Pincelli/phw  
Telephone: 585-588-2728  
Facsimile: 585-477-4646

RECEIVED

MAR 26 2004

Frank Pincelli  
Attorney for Applicants  
Registration No. 27,370

TECHNOLOGY CENTER R3700



78685F-P  
Customer No. 01333

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

John R. Fredlund, et al

SYSTEM FOR DISPLAYING,  
STORING AND RETRIEVING  
IMAGES

Serial No. 09/213,169

Filed 30 November 2000

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Sir:

**RECEIVED**

**MAR 26 2004**

**REPLY BRIEF**

TECHNOLOGY CENTER R3700

Grouping of claims:

The Examiner's argument that the Appeal Brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeals is contained in a brief, and therefore it is presumed that there are none. Applicant believes that an appropriate statement has been provided with regard to related appeals and interferences. For the record, Applicant is not aware of any appeals and interferences directly related to the pending application.

With regard to the claims, the Examiner is correct in that claim 3 should have been provided with the claims of Group II as claim 3 depends upon claim 2.

With regard to groups III, IV and V, these groups are all directed to a system for displaying, storing and retrieving images all of which include the limitation of a silhouette of the plurality of images provided on said first image retaining section of said first side and thus were believed to be sufficiently related

Group Art Unit: 3722

Examiner: Willmon Fridie, Jr.

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*Paula West*  
Paula West

*3-22-04*  
Date

with respect to patentability as they were all grouped in a single grouping and therefore were argued together. However, Applicant agrees to the grouping as suggested by the Examiner.

Response to Examiner's Arguments:

The Examiner argues that item 60a, 61a of Shiota define a silhouette. In this regard the items the Examiner refers to are actually thumbnail images of the images that are on the film. In this regard, Applicant would like to point out that the plain definition of silhouette is directed to "a drawing consisting of the outline of something esp. a human profile, filled with a solid color" or "an outline of an object that appears dark against a light background". See Appendix A attached hereto which is the definition of silhouette found in Webster's II New College Dictionary. See also Appendix B definition of silhouette in Webster's Ninth New Collegiate dictionary which states: "a likeness cut from dark material and mounted on a light ground or one sketched in outline and solidly colored in". This is in contrast to items 60a and 61a of Shiota which is simply a small image of other larger images already present, and thus is not a silhouette as taught and claimed by Applicant. Further, the frame numbers referred to in Applicant's response do not identify the source of the images as taught and claimed by Applicant. They merely identify the location or sequence of the image on the film that captured the image, not the source of the image. Every film has sequence numbers for the frames, thus the frame number could not identify the source from which the image originated as claimed by Applicant.

The Examiner further argues that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Manico et al. with identifying icon with identification numbers which correspond to the images on the album as taught by Shiota in order to categorize the content or provide more information of the images. In this regard, Applicant respectfully submits that there is no teaching, suggestion or motivation to make the combination as suggested by the Examiner. As the CAFC said in *In re Lee* 277 Fed 3<sup>rd</sup> 1338 (61 USPQ 2<sup>nd</sup> 1430) 2002

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness."

The Court further stated:

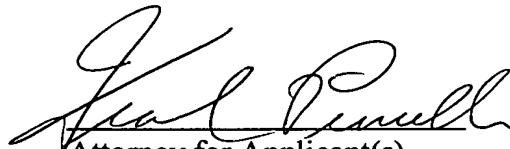
“our case law makes clear that the best defense against the subtle but powerful attraction of hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art .... teachings of references can be combined only if there is some suggestion incentive to do so.” See *In re Lee* at 1433.

“the Examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references.” (see *In re Lee* at 1434).

In the present instance, the Manico reference is directed to an album leaf while the Shiota reference is directed to a photographic printer for printing images on photographic paper. The photographic paper is simply the output of a printer of Shiota in contrast to the album leaf illustrated in Manico. There is no teaching or suggestion of combining one with the other, nor is there any reason or motivation to do so. In addition, as Applicants have previously discussed, there is no teaching or suggestion of providing an icon identifying the source from which images originated as taught and claimed by Applicant, nor does the cited art teach or suggest the silhouette of the images provided on the album leaf as taught and claimed by Applicant.

For the foregoing reasons and reasons previously discussed, Applicant respectfully submit that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read 'Frank Pincelli', written over a horizontal line.

Attorney for Applicant(s)  
Registration No. 27,370

Frank Pincelli/phw  
Rochester, NY 14650  
Telephone: 585-588-2728  
Facsimile: 585-477-4646

Appendix A

Riverside 

---

Webster's II

---

*New College Dictionary*

Words are included in this Dictionary on the basis of their usage. Words that are known to have current trademark registrations are shown with an initial capital and are also identified as trademarks. No investigation has been made of common-law trademark rights in any word, because such investigation is impracticable. The inclusion of any word in this Dictionary is not, however, an expression of the Publisher's opinion as to whether or not it is subject to proprietary rights. Indeed, no definition in this Dictionary is to be regarded as affecting the validity of any trademark.

Copyright © 1995 by Houghton Mifflin Company. All rights reserved.

No part of this work may be reproduced or transmitted in any form or by any means, electronic or mechanical, including photocopying and recording, or by any information storage or retrieval system without the prior written permission of Houghton Mifflin Company unless such copying is expressly permitted by federal copyright law. Address inquiries to Reference Permissions, Houghton Mifflin Company, 222 Berkeley Street, Boston MA 02116.

Illustrations **azimuthal equidistant projection** and **sinusoidal projection** © 1986 by The American Congress on Surveying and Mapping.

*Library of Congress Cataloging-in-Publication Data*

Webster's II new college dictionary.  
p. cm.

ISBN 0-395-70869-9 (alk. paper)

1. English language -- Dictionaries. I. Webster's II new  
Riverside University dictionary  
PE1628.W55164 1995  
423 -- dc20

95-5833  
CIP

For information about this and other Houghton Mifflin trade and reference books and multimedia products, visit  
The Bookstore at Houghton Mifflin on the World Wide Web at  
<http://www.hmco.com/trade/>.

Printed in the United States

## Conter

Editorial and P

Preface . . . . .

Elements of th

Explanatory No

Abbreviations

Pronunciation

DICTIONARY

Abbreviations

Biographical N

Geographic Na

Foreign Words

Four-Year Coll

Two-Year Coll

A Concise Gu

Forms of Addr

Table of Meas

Periodic Table

Signs and Syn

BEST AVAILABLE COPY

\_\_\_\_\_

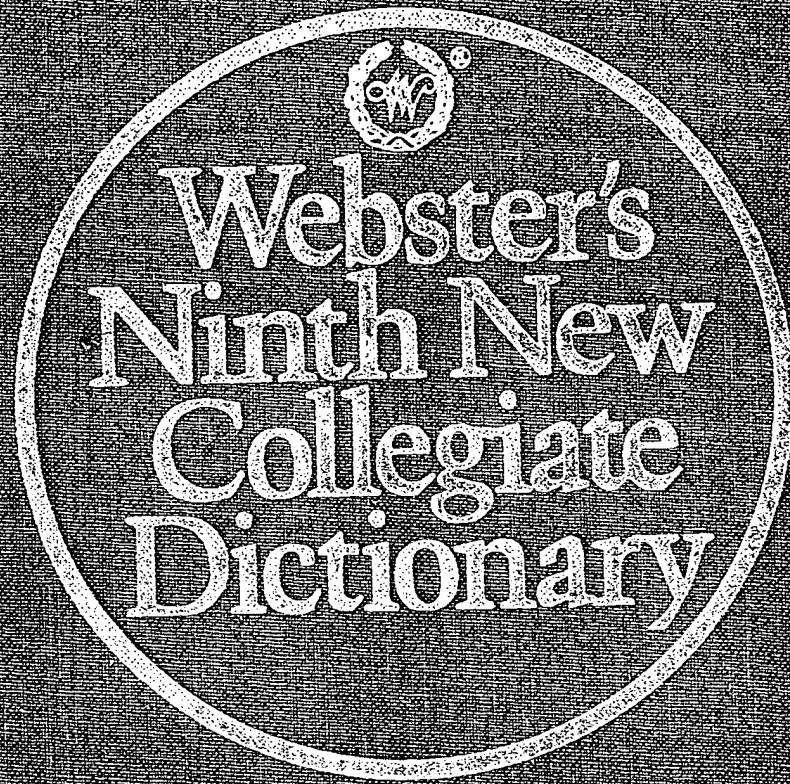
\_\_\_\_\_

\_\_\_\_\_



ou boot ou out th thin th this ū cut ūr urge y young  
rou abuse zh vision ə about, item, edible, gallop, circus





*A Merriam-Webster®*





**A GENUINE MERRIAM-WEBSTER**

The name *Webster* alone is no guarantee of excellence. It is used by a number of publishers and may serve mainly to mislead an unwary buyer.

A *Merriam-Webster*® is the registered trademark you should look for when you consider the purchase of dictionaries or other fine reference books. It carries the reputation of a company that has been publishing since 1831 and is your assurance of quality and authority.

Copyright © 1990 by Merriam-Webster Inc.

Philippines Copyright 1990 by Merriam-Webster Inc.

Library of Congress Cataloging in Publication Data  
Main entry under title:

Webster's ninth new collegiate dictionary.

p. cm.

ISBN 0-87779-508-8. — ISBN 0-87779-509-6 (indexed). — ISBN  
0-87779-510-X (deluxe)

1. English language—Dictionaries.

PE1628.W5638 1990

423—dc20

89-38961

CIP

Webster's Ninth New Collegiate Dictionary principal copyright 1983

COLLEGIATE trademark Reg. U.S. Pat. Off.

All rights reserved. No part of this book covered by the copyrights hereon may be reproduced or copied in any form or by any means—graphic, electronic, or mechanical, including photocopying, taping, or information storage and retrieval systems—without written permission of the publisher.

Made in the United States of America

3940RMcn90

BOMC offers recordings and compact discs, cassettes  
and records. For information and catalog write to  
BOMR, Camp Hill, PA 17012.

Er

Abbrevi:

